



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,957	12/14/2001	Gary M. Rapps	CM02023K	7541

22917 7590 07/08/2003

MOTOROLA, INC.
1303 EAST ALGONQUIN ROAD
IL01/3RD
SCHAUMBURG, IL 60196

EXAMINER

TRAN, SINH N

ART UNIT	PAPER NUMBER
----------	--------------

2643

DATE MAILED: 07/08/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

12

Office Action Summary

Application No.

10/017,957

Applicant(s)

RAPPS, GARY M.

Examiner

Sinh Tran

Art Unit

2643

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 318. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the “space between the first section of the housing and the self-retaining element becomes gradually smaller as the self-retaining element extends further away from the sound delivery tube” (claim 18) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2643

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7, 11, 13 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Strzalkowski (3,035,127).

Regarding claims 1-5, 7, 11, 13, 15, Strzalkowski discloses a communication device for use behind the ear comprising a housing (219, Fig. 25); a sound delivery tube (83); and a self-retaining element (359) coupled to the sound delivery tube, wherein the self-retaining elements rests beneath an inferior crus of the ear (see Fig. 25) and provides retention of the device to the ear when the sound tube is positioned for non-occluded sound delivery (openings 84).

Regarding claim 16, Strzalkowski further discloses that the housing has a first section (the section that rests on the sulcus of the ear, fig. 25).

Regarding claims 17 and 18 and in so far as understood, Strzalkowski further discloses a space between the first section and the self retaining element becomes gradually smaller (the section of the housing that is on the pinna commencement and is gradually becoming smaller before it reaches element 199, Fig. 25).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2643

6. Claims 1, 6-7, 10-13, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevens (4,864,610).

Stevens discloses a communication device for use behind the ear comprising a housing (10); a sound delivery tube (20); and a flexible self-retaining element (23, col. 3, lines 48-49) coupled to the sound delivery tube, wherein the self-retaining elements rests beneath an inferior crus of the ear (see Fig. 1 or 3) and provides retention of the device to the ear when the sound tube is positioned for non-occluded sound delivery (ear cushion 23 dissipates sound, col. 3, lines 30-32; therefore render it non-occluded sound delivery).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strzalkowski or Stevens.

Strzalkowski fails to disclose that the retaining device is an ear mold. Strzalkowski fails to teach that the device is molded onto the sound delivery tube. Molding hearing components into integral unit is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to mold the self-retaining device onto the sound delivery tube of

Art Unit: 2643

Strzalkowski as an integral unit for the purpose of providing a permanent connection so that the tube does not become loose with the device.

Regarding claim 9, Strzalkowski's self-retaining element is an S shaped curve (Fig. 7). However, Strzalkowski fails to disclose that the element is spring curve. Official Notice is taken that earpiece made of flexible material to provide better comfort to the user's ear is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to provide the earpiece self retaining element of Strzalkowski with flexible material for the same purpose as stated above.

Regarding claim 14, Strzalkowski or Stevens fails teach that the communication device is wireless. Wireless hearing aids are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to implement the communication device of Strzalkowski or Stevens wireless since it is well known in the art to overcome the problem of tangled wires.

Response to Arguments

9. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 2643

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sinh Tran whose telephone number is (703) 305-4040. The examiner can normally be reached on M,T&Th 9:00AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Application/Control Number: 10/017,957

Art Unit: 2643

Page 7



Sinh Tran
Primary Examiner
Art Unit 2643

st

June 30, 2003